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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
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HAVERSTOCK & OWENS LLP
162 NORTH WOLFE ROAD
SUNNYVALE, CA 94086

EXAMINER

SORKIN, DAVID L

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 03 18 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/579,938

Applicant(s)

WILLIAMS, TIMOTHY J

Examiner

David L. Sorkin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-11 and 13-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-11,13-19,21-26 and 28 is/are rejected.
- 7) ☒ Claim(s) 20 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Mullen et al. (US 5,673,817). Regarding claim 1 Mullen ('817) discloses a container (11) comprising compartments (18,19,20) each having a front, a back, a first side, a second side and a base; a frame (13) holding the compartments; and means (25) for dispensing removably coupled to the compartments (see col. 4, lines 42-53). While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The container of Mullen ('817) is intended to hold liquids (with examples listed in col. 1, lines 9-16) and clearly would be capable of holding paint. Therefore, the claim is still anticipated even though the reference does not use the word "paint".

Regarding claim 3, the means for dispensing is a spigot assembly (see col. 5, line lines 6 and 7).

3. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by DeVito (US 5,842,606). Regarding claim 1, DeVito ('606) discloses a container comprising a plurality of compartments (a plurality of 34) having a front, a back, a first side, a second side and a base; a frame (a plurality of 12 joined together as disclosed) holding the compartments; and means (52) for dispensing removably coupled to the compartments. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra. Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. The container of DeVito ('606) is intended to hold liquids (see col. 1, lines 6-8) and clearly would be capable of holding paint. Therefore, the claim is still anticipated even though the reference does not use the word "paint". Regarding claim 3, the means for dispensing paint includes a spigot assembly (see Fig. 5). Regarding claim 4, the frame includes mounting slots (38).

4. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Briggs (US 6,109,482). Regarding claim 1, Briggs ('482) discloses an container comprising a plurality of compartments (see Fig. 5); a frame (a plurality of 12 joined together as shown in Fig. 2) holding the compartments; and means (22) for dispensing removably coupled to the compartments for dispensing from the compartments, wherein

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the means for dispensing is capable of dispensing without lifting the compartments.

While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra.

Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. The container of Briggs ('482) is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding paint. Therefore, the claim is still anticipated even though the reference does not use the word "paint". Regarding claim 3, the means for dispensing paint includes a spigot assembly (see Fig. 3). Regarding claim 4, the frame includes mounting slots (42).

5. Claims 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Reed et al. (US 4,311,017). Regarding claim 7, Reed ('017) discloses a container comprising a plurality of compartments (24,27), each having a front, a back, a planar first side and a planar second side and a base (see Fig. 2, 3 and 5; col. 3, lines 15 and 16); a frame (2) holding the compartments; lids (25,26 and/or 3); and a stirring assembly (111,112,113,114) removably coupled to the lid(s). The means for dispensing is capable of dispensing without lifting the compartments. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra. Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the

claims" *In re Otto* supra. The container of Reed ('017) is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding paint. Therefore, the claim is still anticipated even though the reference does not use the word "paint". Regarding claim 9, the frame includes slots (101').

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-6, 10, 11, 13-19 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reed et al. (US 4,311,017). Regarding claim 1, Reed ('017) discloses a container comprising a plurality of compartments (24,27), each having a front, a back, a first side, a second side and a base (see Fig. 2, 3 and 5; col. 3, lines 15 and 16); a frame (2) holding the compartments; and means (15,16) for dispensing. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra. Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. The container of Reed ('017) is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding paint. Therefore, the claims are still unpatentable even though the reference does not use the word "paint". While it is not explicitly stated that the dispensing means

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is removable (although Fig. 3 appears to depict a hex nut), the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 3, the dispensing means is a spigot assembly (see col. 5, lines 11-37). Regarding claim 4, the frame includes slots (101'). Regarding claim 5, one or more removable lids (25, 26 and/or 3) selectively cover the paint compartments, and means for stirring (111, 112, 113, 114) are removably coupled to the lids. Regarding claim 6, the stirring means further comprises a circular base (111' or 114) a rod (112) coupled to the base, and a stirring fan apparatus (113) coupled to the rod. While it is not explicitly stated that the stirring fan apparatus is removable, the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 10, the stirring means further comprises a circular base (111' or 114) a rod (112) coupled to the base, and a stirring fan apparatus (113) coupled to the rod. While it is not explicitly stated that the stirring fan apparatus is removable, the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 11, Reed ('017) discloses a container comprising a plurality of compartments (24, 27), each having a front, a back, a first side, a second side and a base (see Fig. 2, 3 and 5; col. 3, lines 15 and 16); a frame (2) holding the compartments; a dispensing mechanism (15, 16) one or more removable lids (25, 26 and/or 3) covering the

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compartments; and a stirring assembly (111,112,113,114) removably coupled to the lids. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra.

Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. The container of Reed ('017) is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding paint. Therefore, the claims are still unpatentable even though the reference does not use the word "paint". While it is not explicitly stated that the dispensing means is removable (although Fig. 3 appears to depict a hex nut), the reference recognizes advantages, of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 13, the dispensing mechanism includes a spigot assembly (see col. 5, lines 11-37). Regarding claim 14, the frame includes slots (101'). Regarding claim 15, the stirring assembly further comprises a circular base (111' or 114) a rod (112) coupled to the base, and a stirring fan apparatus (113) coupled to the rod. While it is not explicitly stated that the stirring fan apparatus is removable, the reference recognizes advantages, of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 16, Reed ('017) discloses a reusable container comprising a plurality of compartments (24,27); body (2) holding the paint compartments having a front, a back, a planar first side and a planar second side

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(see Fig. 1): one or more removable lids (25, 26 and/or 3) coupled to the paint compartments having an outer side, an inner opposite side and an aperture located through the lid from the outer side to the inner opposite side; a stirring mechanism (111,112,113,114) removably coupled to the outer side of the lids having an integrally formed rod located at a central axis of the stirring mechanism, wherein the rod (112) is positioned through the aperture in the lids; and a stirring fan apparatus (113) coupled to the rod of the stirring mechanism on the inner opposite side of the lids. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra. Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. The container of Reed ('017) is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding paint. Therefore, the claims are still unpatentable even though the reference does not use the word "paint". While it is not explicitly stated that the fan apparatus is removable, the reference recognizes advantages, of making parts removable (see col. 5, lines 35-37). Furthermore, it is has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 17, the body includes slots (101'). Regarding claim 18, the stirring mechanism includes a handle (see col. 6, lines 1 and 15-21). Regarding claim 19, the interior of the compartments has a sloped area and a reservoir area (see Figs. 2 and 3). Regarding claim 22, Reed ('017) discloses a reusable container comprising a body (2) having a first side and a

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second side and a plurality of compartments (24,27) each having a front, a back, a planar first side and a planer second side; one or more removable lids (25, 26 and/or 3) coupled to the compartments having an outer side, an inner opposite side and an aperture located through the lid from the outer side to the inner opposite side; a stirring mechanism (111,112,113,114) removably coupled to the outer side of the lids having an integrally formed rod located at a central axis of the stirring mechanism, wherein the rod (112) is positioned through the aperture in the lids extending into a corresponding compartment; and a fan apparatus (113) coupled to the rod of the stirring mechanism on the inner opposite side of the lids. While the claims include expressions concerning "paint", "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra. Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* supra. The container of Reed ('017) is intended to hold liquids (see col. 1, lines 6-9) and clearly would be capable of holding paint. Therefore, the claims are still unpatentable even though the reference does not use the word "paint". While it is not explicitly stated that the fan apparatus is removable, the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious". *In re Dulberg*, 129 USPQ 349 (CCPA 1961). See also *In re Larson*, 144 USPQ 347, 349 (CCPA 1965) regarding the obviousness of making part integral. Regarding claim 23, the paint compartments are single walled (see Fig. 5). Regarding claim 24, the body includes slots (101').

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Regarding claim 25 the stirring mechanism includes a handle (see col. 6, lines 1 and 15-21). Regarding claim 26, the interior of the compartments has a sloped area and a reservoir area (see Figs. 2 and 3).

8. Claims 21 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reed et al. (US 4,311,017) in view of Briggs (US 6,109,482). The apparatus of Reed ('017), discussed above regarding claims 16 and 22, fails to include rounded ribs and channels. Briggs ('482) discloses rounded ribs (44) and channels/grooves (42). It is considered that it would have been obvious to one of ordinary skill in the art to have provided the apparatus of Reed ('017) with ribs and channels/grooves as taught by Briggs ('482), because Briggs ('482) states that such ribs and grooves provided the benefit of allowing removable side-by-side coupling of a plurality of unit apparatuses (see col. 5, lines 13-32).

Allowable Subject Matter

9. Claims 20 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. All section 112 rejections have been withdrawn in view due to applicant's amendments.

11. Lande (US 5,829,344) is no longer relied upon, because ~~the~~ all the claims now require a plurality of compartments.

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12. With regard to each of the applied references, applicant argues that because the container of the invention is intend to hold paint, while the references do not discuss paint but instead other liquids, the claims should be allowed. However, "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra. Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto*, supra. See also *In re Schreiber*, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997), where a claimed popcorn dispensing spout was held anticipated by a spout for dispensing oil from an oil can.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 8:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


David Sorkin

March 14, 2003


CHARLES E. COOLEY
PRIMARY EXAMINER